

U.S. Serial No. 09/761,203  
Response to the Office action of January 2, 2008

### **Remarks**

The applicants have carefully reviewed the Office action dated January 2, 2008, and the references cited therein. By way of the forgoing amendments, claim 18 has been cancelled, claim 36 has been added, and claims 1, 9, 10, 13, 23, 27, and 32 have been amended. In view of the forgoing amendments and the following remarks, it is respectfully submitted that all pending claims are in condition for allowance and reconsideration is requested.

### **Rejections Under 35 U.S.C. § 112**

Claim 10 has been amended to be dependent upon claim 9, which overcomes the rejection based on antecedent basis.

### **Double Patenting Rejection**

The applicants note that the double patenting rejections are provisional because the copending application (U.S. Patent Application Serial no. 09/836,378) has not yet been allowed. In fact, U.S. Patent Application Serial no. 09/836,378 has become abandoned. Therefore, applicants respectfully request withdrawal of the double patenting rejection.

### **Rejections Under 35 U.S.C. § 103**

Claim 1 was rejected as unpatentable over Kikuchi (US 6,577,811) in view of Pezzillo (US 6,434,621). Claim 1 recites an apparatus comprising, *inter alia*, a receiver for receiving a broadband video signal from a provider and a memory for storing a plurality of selectable status parameters indicating functionality of the digital video recording device, wherein one of said plurality of selectable status parameters is a remaining recording time out of disk space alert user setting received from a user of the digital video recording device. As described below, the combination of Kikuchi and Pezzillo fails to describe or suggest such recitations.

Kikuchi is directed to a digital information recording/playback system. (Col. 2, lines 1-3). The portions of Kikuchi cited in the Office action describe displaying a message indicating an amount of remaining recordable time (Col. 54, lines 24-34; Col. 57, lines 35-37), displaying a message requesting that a disc be loaded (Col. 57, lines 43-45), displaying a message indicating that no recording space remains (FIG. 34, block ST14; Col. 62, lines 12-20), and displaying a message that no disc is available (FIG. 60). However, as admitted in the Office action, Kikuchi

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fails to describe or suggest an out of disk space alert user setting. In other words, Kikuchi does not provide a user of a digital information recording/playback system with control over an out of disk alert. Further, Kikuchi does not describe or suggest that a user may set the amount of remaining recording time at which an out of disk space alert should be generated.

The Office action seeks to cure the deficiencies of Kikuchi by citing Pezzillo, which is directed to an apparatus and method for internet and intranet broadcasting. Pezzillo describes setting an alert to cause an email to be sent to a webcaster when a low disk space condition is reached. However, Pezzillo does not describe or suggest a remaining recording time out of disk space alert user setting. Rather, Pezzillo merely suggests that a webcaster (not a user of a video receiver) can set (or enable) an alert to be sent when a low disk space condition is reached. Pezzillo does not teach or suggest that a user can set or establish a remaining recording time at which an out of disk space alert will be generated. Therefore, because neither of Kikuchi or Pezzillo describes or suggests a remaining recording time out of disk space alert user setting, claim 1 and all claims depending therefrom are patentable over Kikuchi and Pezzillo.

Further, one of ordinary skill in the art would not be motivated to combine the description of Kikuchi with the description of Pezzillo to arrive at the claimed invention. Kikuchi is directed to an end-user video recording device that displays a message indicating that no recording space remains. In contrast, the cited portions of Pezzillo are directed to sending alerts to a webcaster. In other words, while Kikuchi is an end-user focused system, the low disk space alert of Pezzillo is sent to a webcaster managing a distribution headend. In other words, Kikuchi and Pezzillo are directed to nearly opposite ends of a video distribution system. Further, Kikuchi and Pezzillo are directed to operations on different apparatus. While Kikuchi is directed to displaying an out of disk space message on a video recording/playback system, Pezzillo is directed to a low disk space condition for an internet webcasting station.

The motivation for combination of Kikuchi and Pezzillo provided in the Office action does not overcome the noted differences. Rather, it is respectfully submitted that the provided motivation is so abstract that it cannot support a *prima facie* case of obviousness. “[I]t would have been obvious to modify Kikuchi [in light of Pezzillo] by providing an out of disk alert user setting in order to cause an action.” (Page 3, lines 15-18). Such a motivation could be advanced

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for the combination of virtually any two systems. The performance of a generic action is not a valid motivation for the combination of two disparate descriptions. Therefore, in light of the deficiencies of the rejection and the references cited therein, withdrawal of the rejection is respectfully requested.

Claim 27 recites a method comprising, *inter alia*, storing a plurality of selectable status parameters indicating functionality of a digital video recording device within a memory of the digital video recording device, wherein one of said plurality of selectable status parameters is a remaining recording time out of disk space alert user setting received from a user of the digital video recording device. Claim 32 recites an apparatus comprising, *inter alia*, a memory for storing a plurality of selectable status parameters indicating functionality of a digital video recording device, wherein one of said plurality of selectable status parameters is a remaining recording time out of disk space alert user setting received from a user of the digital video recording device. As described in conjunction with claim 1, the combination of Kikuchi and Pezzillo fails to describe or suggest a remaining recording time out of disk space alert user setting. Therefore, claims 27, 32, and all claims depending therefrom are in condition for allowance.

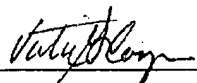
Reconsideration of the application and allowance thereof are respectfully requested. If there is any matter that the examiner would like to discuss, the examiner is invited to contact the undersigned representative at the telephone number set forth below.

Respectfully submitted,

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The DIRECTV Group, Inc.  
CA/LA1/A109  
2230 E. Imperial Highway  
El Segundo, CA 90245

Telephone No. 310-964-0735

  
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Victor G. Cooper  
Reg. No. 39,641  
Attorney for Applicant